REMARKS

In the Office Action mailed on June 17, 2003, claims 1-16, 18, 22-26, 31-33, 34-47, 49, and 51-58 were rejected under 35 U.S.C. § 102(b) based on Apple Corps. Further, these claims were rejected under 35 U.S.C. § 103(a) based on Rose, U.S. Patent Number 5,930,769 in view of Lands' End My Model (Lands' End).

In addition, claims 17, 20, 21, and 48 were rejected under 35 U.S.C. §103(a) based on Apple Corps in view of Utsugi, U.S. Patent Number 6,502,583 and based on Rose in view of Lands' End and further in view of Utsugi. Finally, claims 19, 27-30, and 50 were rejected under 35 U.S.C. § 103(a) based on Apple Corps in view of Linford et al. U.S. Patent Number 6,081,611 and all of those claims, except claim 50, were rejected in a similar rejection based on Rose in view of Lands' End and Linford et al.

By this Amendment, Applicants have amended claims 1-4, 22-25, 29, 31, 34-37, and 52-55. For at least the reasons discussed below, Applicants respectfully request that the claim rejections under 35 U.S.C. §§ 102(b) and 103(a) be withdrawn and these claims allowed.

1. Rejection of claims 1-16, 18, 22-26, 31-33, 34-47, 49, and 51-58 under 35 U.S.C. § 102(b)

Claim 1, as amended, is patentable over Apple Corps because that reference does not teach enabling an individual to select a cosmetic product and enabling the individual to simulate use of the selected cosmetic product on a simulated facial image.

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Apple Corps is directed to an Internet implementation of a children's game known as Mr. Potato Head. Apple Corps discloses an apple and a head on which eyes, noses, eyeglasses, etc. can be placed for entertainment purposes.

In contrast, claim 1 recites, among other things, enabling an individual to select a cosmetic product and enabling the individual to simulate use of the selected cosmetic product on a simulated facial image. Because Apple Corps does not teach all of the subject matter of claim 1, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 102(b) based on Apple Corps.

Claims 2-16, 18, 22-26, and 31-33 depend, directly or indirectly, from claim 1 and thus are patentable for at least the reasons given above with respect to claim 1.

Claim 34, as amended, is patentable over Apple Corps because that reference does not teach selecting a cosmetic product and causing a simulation of use of the selected cosmetic product on a simulated facial image. As discussed above, Apple Corps is directed to an Internet implementation of a children's game known as Mr. Potato Head and does not teach the claimed invention. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 34 under 35 U.S.C. § 102(b) based on Apple Corps.

Claims 35-47, 49, and 51-58 depend, directly or indirectly, from claim 34 and thus are patentable for at least the reasons given above with respect to claim 34.

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2. Rejection of claims 1-58 under 35 U.S.C. § 103(a)

With respect to the rejection of claims 17, 20-21, and 48 under 35 U.S.C. § 103(a) as being unpatentable over Apple Corps in view of Utsugi, Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. M.P.E.P. § 2143. Second, there must be a reasonable expectation of success. Id. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements. Id. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. M.P.E.P. § 706.02(j) (citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

Applicants respectfully submit that the there is no *prima facie* case of obviousness because one of ordinary skill in the art would not have had any motivation or suggestion to combine the two references in the manner suggested by the Examiner. Utsugi is directed to determining a desirable face and then subjecting an original facial image, acquired by a camera, to image processing to make it similar to the desirable face. (col. 2, ll. 29-34). That disclosure is significantly different from the disclosure of Apple Corps relating to a game/toy similar to Mr. Potato Head. A person of ordinary

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skill in the art would not have had any reason to combine such non-analogous arts and thus claims 17, 20-21, and 48 are patentable for at least this reason.

Concerning the rejection of claims 19, 27-30, and 50 under 35 U.S.C. § 103(a) over Apple Corps in view of Linford et al., Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

Linford et al. does not cure the above-noted deficiencies of Apple Corps. Linford et al. is directed to an imaging system that allows a physician, such as a cosmetic surgeon to display more realistic images of the results that may be obtained by a patient from cosmetic surgery. (col. 2, ll. 44-55). The Figures cited by the Examiner (i.e., Figs. 14A-D, 15A-C, 18A-B, and 20) relate to, among other things, for example comparing pre-surgical images to post-surgical images of the patient. Linford et al., however, does not teach or suggest (1) enabling an individual to select a cosmetic product and enabling the individual to simulate use of the selected cosmetic product on a simulated facial image, as recited in claim 1; or (2) selecting a cosmetic product and causing a simulation of use of the selected cosmetic product on a simulated facial image, as recited in claim 34. Thus, Applicants respectfully request that the Examiner withdraw the rejection of claims 19, 27-30, and 50 under 35 U.S.C. § 103(a).

Further, Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness because there would have been no motivation or suggestion to combine the two references in the manner suggested by the Examiner. Apple Corps and Linford et al. are from completely different fields of art.

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While Apple Corps relates to Internet based games/toys, Linford et al. relates to an imaging system that allows a physician, such as a cosmetic surgeon, to display more realistic images of the results that may be obtained by a patient from cosmetic surgery. Thus, Applicants respectfully submit that a person of ordinary skill in the art would not have had any reason to combine the non-analogous art of Apple Corps and Linford et al. and thus claims 19, 27-30, and 50 are patentable for this additional reason.

With respect to the rejection of claims 1-16, 18, 22-26, 31-33, 34-47, 49, and 51-58 under 35 U.S.C. § 103(a) over Rose in view of Lands' End, Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons. Regarding claim 1, neither Rose nor Lands' End, taken alone or in combination, teaches or suggests enabling an individual to select a cosmetic product and enabling the individual to simulate use of the selected cosmetic product on a simulated facial image.

Rose is directed to an electronic clothes shopping system where a shopper can provide body measurements and the system can then suggest clothing fashion categories appropriate for a body type that is determined based on the provided body measurements. (col. 1, ll. 53-64).

Lands' End briefly describes an Internet based system for building a virtual model corresponding to a user's body shape, build, shoulder type (narrow or broad), height, and weight. The user can also select hairstyle, hair color, look, and facial hair color for the virtual model. Further, the user can select the shape of eyes: round or almond, the width of nose: narrower or wider, and the type of lips: fuller or thinner. Finally, the user can select a face from the four optional faces presented to the user.

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In contrast, as noted above, claim 1, as amended, recites, among other things, enabling an individual to select a cosmetic product and enabling the individual to simulate use of the selected cosmetic product on a simulated facial image. Thus, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) over Rose in view of Lands' End.

Claims 2-16, 18, 22-26, and 31-33 depend, directly or indirectly, from claim 1 and thus are patentable for at least the reasons given above with respect to claim 1.

Regarding claim 34, neither Rose nor Lands' End, taken alone or in combination, teaches or suggests selecting a cosmetic product and causing a simulation of use of the selected cosmetic product on a simulated facial image. Thus, Applicants respectfully request that the Examiner withdraw the rejection of claim 34 under 35 U.S.C. § 103(a) over Rose in view of Lands' End.

Claims 35-47, 49, and 51-58 depend, directly or indirectly, from claim 34 and thus are patentable for at least the reasons given above with respect to claim 34.

In addition, Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness of claims 1-16, 18, 22-26, 31-33, 34-47, 49, and 51-58 under 35 U.S.C. § 103(a) over Rose in view of Lands' End. For example, the Office Action does not establish any suggestion or motivation to combine the two references. Applicants note that the first page of the Lands' End reference includes a notice reflecting a license under U.S. Patent No. 5,930,769, which is the Rose patent, but that notice alone does not provide any evidence of a motivation or suggestion to combine the two references. Accordingly, for this additional reason, Applicants respectfully

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request that the Examiner withdraw the rejection of claims 1-16, 18, 22-26, 31-33, 34-47, 49, and 51-58 under 35 U.S.C. § 103(a) over Rose in view of Lands' End.

Regarding the rejection of claims 17, 20-21, and 48 under 35 U.S.C. § 103(a) over Rose in view of Lands' End and Utsugi, Applicants respectfully submit that the claim rejection should be withdrawn because the claims included in that rejection depend from claims 1 and 34, which are allowable for the reasons discussed above. Furthermore, there would have been no motivation or suggestion to combine the non-analogous teachings of these references.

Concerning the rejection of claims 19 and 27-30 under 35 U.S.C. § 103(a) over Rose in view of Lands' End and Linford et al., Applicants respectfully submit that this claim rejection should also be withdrawn. Furthermore, there would have been no motivation or suggestion to combine the non-analogous teachings of these references, because each of the claims included in the rejection depends, directly or indirectly, from claim 1, which is allowable for the reasons discussed above

Applicants respectfully request the reconsideration of this application, withdrawal of all of the claim rejections, and the timely allowance of the pending claims.

On April 17, 2003, Applicants filed an Information Disclosure Statement (IDS). The Office Action lacks any indication of whether the Examiner has considered any of the documents submitted with that IDS. Applicants respectfully request that the Examiner consider the submitted documents and indicate that they were considered by making appropriate notations on the PTO 1449 form submitted as part of the April 17, 2003 IDS.

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The Office Action contains a number of statements reflecting characterizations of the claims and/or the related art. Regardless of whether any such statements are addressed above, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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Dated: September 16, 2003

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